

16288

PTO/SB/17 (10-02)

Approved for use through 10/31/2002. OMB 0651-0032

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FEE TRANSMITTAL for FY 2003

Patent fees are subject to annual revision.

Complete if Known

Application Number 10/071890
Filing Date February 7, 2002
First Named Inventor John V. Frangioni
Examiner Name H. Reyes
Group Art Unit 1625

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 55.00

Attorney Docket No. BIDM-P01-004

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account

Deposit Account Number

18-1945

Deposit Account Name

Ropes & Gray

The Commissioner is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	750	2001	375	Utility filing fee	
1002	330	2002	165	Design filing fee	
1003	520	2003	260	Plant filing fee	
1004	750	2004	375	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$ 0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims ** = x =
Independent Claims ** = x =
Multiple Dependent =

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	84	2201	42	Independent claims in excess of 3
1203	280	2203	140	Multiple dependent claim, if not paid
1204	84	2204	42	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ 0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	55.00
1252	410	2252	205	Extension for reply within second month	
1253	930	2253	465	Extension for reply within third month	
1254	1,450	2254	725	Extension for reply within fourth month	
1255	1,970	2255	985	Extension for reply within fifth month	
1401	320	2401	160	Notice of Appeal	
1402	320	2402	160	Filing a brief in support of an appeal	
1403	280	2403	140	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,300	2453	650	Petition to revive - unintentional	
1501	1,300	2501	650	Utility issue fee (or reissue)	
1502	470	2502	235	Design issue fee	
1503	630	2503	315	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	750	2809	375	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	750	2810	375	For each additional invention to be examined (37CFR 1.129(b))	
1801	750	2801	375	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 55.00

SUBMITTED BY

Name (Print/Type) Yu Lu

Registration No. (Attorney/Agent)

50,306

Complete (if applicable)

Telephone (617) 951-7268

Signature

Date

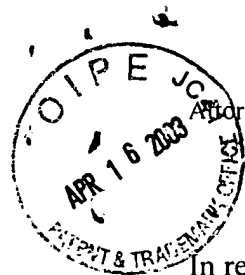
April 11, 2003

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, Washington, DC 20231, on the date shown below.

Dated: 4/11/03

Signature: Joanne Ryan

(Joanne Ryan)



Attorney Docket No.: BIDM-P01-004

#8
m.m.
4/23/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

FRANGIONI

Serial No: 10/071,890

Filed: February 7, 2002

For: MODIFIED PSMA LIGANDS AND
USES RELATED THERETO

Attorney Docket No. BIDM-P01-004

Art Unit: 1625

Examiner: Reyes, H.M.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Commissioner for Patents Washington, D.C. 20231 on the date indicated below:

April 11, 2003

Date of Signature
and of Mail Deposit


Joanne Ryan

Commissioner for Patents
Washington, D.C. 20231

REPLY TO RESTRICTION REQUIREMENT

Sir:

This response is filed in reply to the outstanding Restriction Requirement, mailed February 11, 2003, in connection with the above application. The period for response has been extended to April 11, 2003, by the accompanying petition for one month extension. Applicants hereby elect Group VI (claims 17, and 21-65), *with traverse*, on the following grounds.

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Applicants traverse this restriction requirement on the basis that at least Groups I - IX are so closely related and they share the common structural features as described in the specification, with one of the primary differences being the site used for attaching the "R" group. Therefore, a search using the common structural feature (such as the region used for binding PSMA as exemplified in Figure 9) would necessarily search the subject matter encompassing all these related Groups, even though compounds encompassed by these Groups may be patentably distinct. Thus, simultaneous searching of all these groups and examination of all pending claims can be made without imposing additional serious burden on the Examiner. Accordingly, reconsideration and withdrawal of the restriction requirement are respectfully requested.

Regarding species election, Applicants first note that the Office Action listed Group VI with Group I – V in “(A)” for species election purpose, while Applicants assume that this is a mistake since there is no “X” and “Y” in formula II of Group VI claims. Thus Applicants believe Group VI should be listed with Groups VII-VIII in “(B)” for species election purpose.

Applicants hereby provisionally elect, *for search purpose only*, a Group VI Species with R representing a chelate ligand, R3 representing –alkyl-CO₂R4, R2 and R4 each representing hydrogen, and n = 2, *with traverse*. Applicants elect this species with traverse, because the various compounds / species falling within the scope of generic claim 17 (formula II) are different species of the same broad genus with only minor structural variations. These species are related in structure and function, and therefore searching the elected species with the common backbone structure would entail searching the subject matter of all encompassed species. Thus, it would not constitute a significant additional burden to search all encompassed species simultaneously.

Presently, claims 17 and 21-24, 26-40, 43-56, 58-65 read on the elected species.

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” (MPEP803).

In addition, Applicants note that at least claim 17 is a generic claim linking elected and non-elected species. Claims 21-65 are dependent claims on claim 17 and include all limitations of the generic claim 17. Pursuant to MPEP 809.04, “[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim.” Thus, restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 (MPEP 809.02(a)).

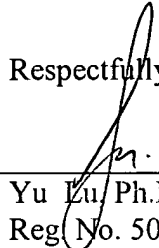
Furthermore, this section indicates that the burden is on the Examiner to examine these generic claims throughout their scope, together with any claims dependent thereon drawn to non-elected species or inventions, rather than for Applicants to limit the scope of the generic claims to conform to the scope of any species or inventions listed in a Restriction Requirement.

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition therefor and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Respectfully Submitted,

Date: April 11, 2003

Customer No: 28120
Docketing Specialist
Ropes & Gray
One International Place
Boston, MA 02110
Phone: 617-951-7000
Fax: 617-951-7050



Yu Lu/ Ph.D.
Reg No. 50,306